INVENTOR: Deonarine, Victor S/N: 09/683,353

REMARKS

Claims 1-24 are pending in the present application. In the Office Action mailed February 27, 2003, claims 16 and 17 were finally rejected under 35 U.S.C. §102(b) as being anticipated by Ribi (USP 5,918,981). Claims 1, 3, 5, 6, 9, and 16-20 were finally rejected under 35 U.S.C. §103(a) as being unpatentable over OMEGAMARKER® Temperature Test Kit. Claims 10, 11, 14, and 15 were finally rejected under 35 U.S.C. §103(a) as being unpatentable over Whitfield et al. (USP 4,473,113) in view of Deats (USP 515,075). New claims 21-24 combine that subject matter indicated allowable.

Applicant appreciates the Examiner's indication of allowability of claims 2, 4, 7, 8, 12, and 13. New claims 21-24 are presented herein to incorporate the subject matter of these claims.

IDS

In the Office Action dated February 27, 2003, the Examiner states the "information disclosure statement filed February 11, 2003 fails to comply with 37 CFR 1.97(c) because it lacks a statement as specified in 37 C.F.R. 1.97(e)." The Examiner further states that the document has been placed in the application file but the information referred to therein have not been considered. The submission was made in response to the Examiner's statements on Page 2 of the December 20, 2002 Office Action.

That statement outlines that the original Information Disclosure Statement, as filed, was damaged during mailing. The statement further outlines that the mailed documents were not so damaged that a legible copy could not be created. The Office further gave the Applicant the choice of inspecting, or requesting a copy of the Office's copy. The Applicant was offered the additional option, if the Applicant did not consider the Office's copy to be accurate, to "provide a copy of the above-identified papers ... with a statement that such a copy is a complete and accurate copy of the originally submitted documents." Additionally, the Examiner explicitly stated: "if applicant provides such a copy of the above-identified papers and statement within THREE MONTHS of the mail date of this office action, the office will add the original mailroom date and use the copy provided by applicant as the permanent Office record of the above-identified papers in place of the copy made by the Office." See Page 2 of Office Action mailed 12/20/2002.

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In the Response to the Office Action mailed 12/20/2002, on page 2, Applicant stated:

> "Applicant requests that the documents included herein be used to replace the Office's copy of the aforementioned documents. Please find included a complete and accurate copy of the originally submitted documents. These documents include a copy of the returned return post card, a signed copy of the originally submitted Information Disclosure Statement under C.F.R. §1.97/99."

Additionally, the original Information Disclosure Statement, as filed, was mailed over nine months prior to the mailing of the first Office Action. As such, the original Information Disclosure Statement, as filed, satisfied the filing requirements of 37 C.F.R §1.97(b)(3). Therefore, the filing of the replacement paperwork, as requested by the Office, is not required to satisfy the requirements of 37 C.F.R. 1.97(e).

In light of the above, Applicant again requests that the submission included in the Amendment/Response faxed to the Examiner on February 11, 2003 be used as the permanent Office record of the above-identified papers in place of the copy made by the Office.

Finality of Office Action

The Examiner also made the February 27, 2003 Office Action final. Applicant believes the finality of the present Office Action is improper.

In the first Office Action, the Examiner cited the Omega reference and acknowledged that the reference had no date. In the Notice of References Cited, line U, the citation is stated as, "OMEGA, Brochure for "OMEGAMARKER® Temperature Test Kit", No date." The Examiner states on pages 6-7 of the present Office Action that the "Applicant's arguments to the rejections based on the OMEGAMARKER® do not comply with 37 C.F.R. §1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made." Applicant offered no such arguments nor was the Applicant required to do so.

Such a line of reasoning assumes that Applicant accepts OMEGAMARKER® as prior art when such was not the case. The Examiner rejected claims 1, 3, 4, 6, 9, and 16-20 through application of a reference without a date. In providing a reference without a date the Examiner did not satisfy the burden of showing that the reference is actually prior art predating the present application. In the response to the first Office Action, Applicant provided no remarks regarding the substance of the rejections based on the OMEGAMARKER® reference because the application of the reference to the claims of the present invention was unsustainable without some

indication that the reference is actually prior art. The Examiner provided nothing to indicate as much. Therefore, the first Office Action was incomplete. Applicant need not define its invention over references that are not prior art.

MPEP §2271 states that, "Before a final action is in order, a clear issue should be developed between the examiner and the patent owner. To bring the prosecution to a speedy conclusion and at the same time deal justly with the patent owner and the public, **the examiner will twice provide** the patent owner with such information and references as may be useful in defining the position of the Office as to unpatentability before the action is made final." The Examiner has not afforded the Applicant such an opportunity because the first Office Action was incomplete. Because this is the Applicant's first opportunity to respond to a dated OMEGAMARKER® reference, the finality of the present office action is premature and as such should be withdrawn.

§102 Rejection

Substantially, the Examiner rejected claims 16 and 17 under §102(b) as being anticipated by Ribi stating that "Since the probe 10 disclosed by Ribi shows individual stripes i.e., 16/18/20, indicating different temperature, each indicator strip is considered a separate means for indicating. Moreover, the claim language does not preclude a first and second indicating means to be mounted on the same structure." Claim 16 calls for a dual temperature indicator apparatus having a "first means for indicating a first temperature, a second means for indicating a second temperature, and a means for retaining the first means to the second means in a side-by-side relationship to form an indicator stick assembly capable of indicating at least two temperatures." Claim 17 further defines the apparatus of claim 16 having "a means for controlling movement of the first and second means."

MPEP §2181 states that:

> "When making a determination of patentability under 35 U.S.C. 102 or 103, past practice was to interpret a "means or step plus function" limitation by giving it the "broadest reasonable interpretation." Under the PTO's long-standing practice this meant interpreting such a limitation as reading on any prior art means or step which performed the function specified in the claim without regard for whether the prior art means or step was equivalent to the corresponding structure, material or acts described in the specification. However, in Donaldson, the Federal Circuit stated: Per our holding, the "broadest reasonable interpretation" that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. ***Accordingly, the PTO may not disregard the structure disclosed in the***

specification corresponding to such language when rendering a patentability determination."

In stating the rejection, the Examiner states that "the claim language does not preclude the first and second indicating means to be mounted on the same structure." The third element of claim 16 calls for a means for retaining the first temperature indicating means to the second temperature indicating means. Additionally, the specification recites:

> "A dual temperature indicator stick apparatus has a first means for indicating a first temperature, and a second means for indicating a second temperature. Such means can include a first and second temperature indicator stick. The apparatus further has a means for retaining the first means to the second means in a side-by side relationship to form an indicator stick assembly capable of indicating at least two temperatures." Page 11, paragraph 3.

Applicant believes this claim language, when read with the disclosure, not only defines the invention over Ribi, but when considered in conjunction with MPEP §2181, renders the Examiner's rejection unsustainable. The Examiner's conclusion that there exists a means for connecting the first temperature indicator means to the second temperature indicator means is not supported by the disclosure of Ribi.

Applicant would not disagree that the temperature detection device of Ribi could detect a first and a second temperature. Applicant, however, does not agree that the device of Ribi is a first and a second means for detecting a first and second temperature but rather is a **single means** of detecting multiple temperatures. In stating the rejection to claims 16 and 17, the Examiner has disregarded that structure disclosed in the specification of the pending application that the temperature indicator stick apparatus include a first and a second means of indicating temperature and a means for retaining the first means to the second means. If the first and second indicator means were on the same structure, as suggested by the Examiner, the third limitation of the claim would become superfluous. That is, there would be no need for a means to secure the first temperature means to the second temperature means. The Examiner's own interpretation of allowable claims 16 and 17 admit as much when considered in light of the structure within the specification as is required by MPEP §2181.

As stated in Ribi: "One can introduce the temperature probe into the meat, allow it to remain in the meat, ... and then remove the device from the meat. Depending on the temperature of the meat, one or more stripes will undergo a temperature transition from blue to red." Col. 9, lns. 25-31. As such, the device of Ribi provides a single means, the temperature probe 10, for indicating several temperatures, 16, 18, 20; Fig. 1. That is, the temperature indicating means of

Ribi will indicate the highest temperature that it reaches, not a first or a second temperature. This is not a first means for indicating a first temperature and a second means for indicating a second temperature as called for in claim 16. Additionally, because there is only a single means of indicating multiple temperatures in Ribi, the means for retaining the first means to the second means, as called for in claim 16, is not disclosed.

As such, Applicant believes that which is called for in claim 16 is patentably distinct over Ribi and respectfully requests allowance for claim 16 and those claims dependent therefrom.

The Examiner next rejected claims 1, 3, 5, 6, 9, and 16-20 under §103(a) over OMEGAMARKER® Temperature Test Kit in view of Deats. At this time, Applicant submits for consideration, the following amendments and remarks regarding the patentability of the above claims over the OMEGAMARKER® reference, as the Examiner has, for the first time, substantiated the validity of the applicability of the reference to the present invention.

Claim 1 has been amended to call for "a one-piece connector physically connecting the first and second indicator sticks along different axes." The combination drafting instrument of Deats requires "a pair of companion clips". Pg. 2, lns. 36-37. Additionally, "the two clips are when assembled of the same diameter, in that by alternately arranging their terminals they are spread to the same degree. The outer terminal has secured in any suitable manner thereto a metal block 3, which together with the several terminals, is perforated as at 4, the perforations in the terminals are plain while that of the block is threaded, and located therein is a thumb-screw 5." Pg. 2, lns. 40-49. Minimally, the connector of Deats requires four pieces; the two clips, the metal block, and the thumb-screw. As such, the connector of Deats is not one-piece. Therefore, Applicant believes claim 1 to be patentably distinct over the art of record. As such, Applicant requests allowance of claim 1 and those claims that depend therefrom.

Claim 16 calls for a "means for retaining the first means to the second means in a side-by-side relationship to form an indicator stick assembly capable of indicating at least two temperatures." As discussed above regarding claim 1 and previously regarding claim 16, the connector of Deats is not a means for retaining a first means to a second means. Deats states that "whereby the clips may be drawn snugly together and about ordinary lead pencils 6 which they receive, whereby said pencils are clamped in position. The clips themselves are constructed of sheet metal and are sufficient to secure the pencils in position and are simply aided by the thumbscrew." Pg. 2, lns. 56-63. There is not a means for retaining the first means to the second means, rather Deats discloses a first means and a second means,+ i.e. the clips, for retaining the first and second means.

As such, Applicant believes that which is called for in claim 16, when read in light of the specification, as discussed previously and required by MPEP §2181, is patentably distinct over the art of record. As such, Applicant requests a notice of allowance of claim 16 and those claims that depend therefore.

§103 Rejection

The Examiner further rejected claims 10, 11, 14, and 15 under 35 U.S.C. §103(a) as being unpatentable over Whitfield et al. (USP 4,473,113) in view of Deats (USP 515,075). Referencing Whitfield et al., the Examiner states that "the material is shaped into a lead and housed by a plastic marker pencil housing, the disclosure further describing the manner of applying the material be rubbing and stating a temperature range for melting the material to be 50°C to 60°C. Taking into account all of these features, said lead is considered to be a temperature indicator." Applicant disagrees.

Under this interpretation, any material applied to a structure would satisfy the Examiner's definition of a temperature indicator as all materials have some melting point. Such an interpretation is repugnant to that taught in the application and the prior art in this technology and to one skilled in the art. Additionally, Whitfield et al. does not "state a temperature range for melting the material to be between 50°C to 60°C" as stated by the Examiner. Whitfield et al. does state "these materials **may** be heated to a molten state at 50°C to 60°C and applied with a brush to the heat sink surface to which a power transistor is to be mounted." Col. 6, lns. 48-50 That is, a user would apply heat to the material until it melts. The phase, and not the temperature, is the desired indicator. Said in another way, a user of the conductor material of Whitfield et al. does not care what the temperature of the material is, but rather when the material changes phases.

Use of the material of Whitfield et al. also evidences the disinterest in whether the material changes phase.

> "In both the pencil and the automatic dispenser form the material is used by rubbing an end of the rod over one of the surfaces to be engaged when an electronic device is mounted on the heat sink. Rubbing continues unlit the surface is covered by a thin layer of material excoriated from the rod. Thereafter, the electronic device and heat sink are connected. During operation of the apparatus, the mixture **may** become molten. During servicing of the appartus, when it is cooled and at normal room temperature, the mixture will again become a solid." Col. 7, lns. 17.

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As such, when exposed, the material will be solid, and when in use the material may be solid. That is, the material may never change phase during use thereby "indicating" nothing. As such, the material of Whitfield et al. is not a "temperature indicator."

Therefore, Applicant believes claim 10, and those claims that depend therefrom are patentably distinct over the art of record. As such, Applicant requests allowance of claims 10-15.

Applicant presents new claims 21-24. Claim 21 is the combination of the allowable subject matter of claims 1 and 2. Claim 22 is the combination of claims 1, 3, and 4. Claim 23 is formerly claim 7 with the appropriate change of dependency to new claim 23. Claim 24 is the combination of the subject matter of claims 1 and 8. Applicant believes all of the claims of the present application, new and as amended as provided herein, to be in condition for allowance over the art of record for the reason stated above. As such, Applicant respectfully requests a Notice of Allowance of claims 1-24.

A credit card authorization in the amount of $408.00 is also enclosed for any fees associated with entering the claims newly presented herein.

Applicant appreciates the Examiner's consideration of these Amendments and Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,

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